

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q88476

Gerard EMMER

Appln. No.: 10/540,141

Group Art Unit: 1791

Confirmation No.: 7199

Examiner: Suzanne E MCDOWELL

Filed: August 9, 2005

For: METHOD AND INSTALLATION FOR THE PRODUCTION OF A PLASTIC
CONTAINER

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated May 13, 2009. Entry of this Reply Brief is respectfully requested.

Table of Contents

STATUS OF CLAIMS	2
GROUND OF REJECTION TO BE REVIEWED ON APPEAL	3
ARGUMENT	4
CONCLUSION	7

STATUS OF CLAIMS

Claims 1 and 3-33 are all the claims pending in the application. Claims 22, 24 and 28 stand finally rejected and are the subject of this Appeal. Claims 1 and 3-21 are allowed and claims 23, 25-27 and 29-33 are objected to as being dependent upon a rejected base claim, but would be allowed if rewritten in independent form. Claim 2 is canceled.

REPLY BRIEF UNDER 37 C.F.R. § 41.41
Application No.: 10/540,141

Attorney Docket No.: Q88476

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

(1) Claims 22, 24 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dusterhoft (US Pub. 2002/0062161).

ARGUMENT

I. Claim Rejections – 35 U.S.C. § 103(a)

Claims 22, 24 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dusterhoft (US Pub. 2002/0062161).

Appellants submit the present claims are allowable over Dusterhoft for those reasons set forth in the Appeal Brief and for the additional reasons set forth below.

In the Response to Arguments section of the Examiner's Answer, the Examiner contends that a recitation of intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. *See* Examiner's Answer, p. 3. Further, the Examiner contends that if the prior art structure is capable of performing the intended use, then it meets the claim. *Id.* Finally, the Examiner alleges that Dusterhoft includes a controllable pressure control apparatus (26), which is capable of controlling an injection parameter of the fluid so that the final internal volume of the container falls within predetermined limits with respect to a reference volume. *Id.*

Appellants respectfully disagree. First, the Examiner concedes that Dusterhoft fails to disclose a controller which controls the injection parameter as recited in claim 22. Second, the Examiner's contention that Dusterhoft's controllable pressure apparatus 26 is capable of performing this function is unsupported.

Claim 22 recites, *inter alia*, a control unit for controlling at least one injection parameter of the fluid in order to control the expansion of the preform to produce the final container,

wherein the at least one injection parameter of the fluid is controlled so that a final internal volume of the container falls within predetermined limits with respect to a reference volume.

Thus, claim 22 requires a control unit configured to carry out the control of the injection parameter and, thereby, the expansion of the preform.

First, in the Final Office Action, the Examiner concedes that Dusterhoft fails to disclose a controller which controls an injection parameter as required by claim 22.

While Dusterhoft does not specifically teach that an injection parameter of the fluid is controlled according to instant claim 22, Dusterhoft teaches a controllable pressure apparatus (26). The apparatus taught by Dusterhoft is capable of performing the instantly claimed function which, is should be noted, is a method limitation and does not materially affect the apparatus.

(Final Office Action, p. 2).

Second, Dusterhoft only discloses a controller which provides a defined pressure and fails to contemplate using this controller to control the volume of a container. Consequently, there is absolutely no support for the Examiner's position that this controllable pressure apparatus is capable of controlling an injection parameter such that the container falls within predetermined limits with respect to a reference volume. This is further evidenced by Dusterhoft's failure to disclose any supplemental monitoring equipment associated with the pressure to even permit volumetric control, *e.g.*, flow rate monitoring, which would permit volumetric control.

Conversely to the requirements of claim 22, Dusterhoft appears to only use a localized application of energy in the form of heat to control the deformation of a container. *See par.* [0048]; Fig. 2. More specifically, Dusterhoft uses a geometry measuring device to measure the

body 3. *See* para. [0048]. Based on this measurement, Dusterhoft calculates an energy profile to be locally applied in the local deformation zones 6. *Id.*

In particular, Dusterhoft provides:

The amount of energy and the level of deformability, respectively, of the body 3 is varied by a variation of the term of usage, intensity, pulse width or focus size of the laser beam 15 . . . the desired deformation of the body 3 results exclusively in the actual local deformation zone.

Para. [0048].

In conclusion, the Examiner's contention that Dusterhoft's controllable pressure apparatus (26) is capable of controlling an injection parameter as required by claim 22, is wholly unsupported.

Therefore, Appellant submits claim 22 is allowable for at least these reasons. Additionally, Appellant submits claims 24 and 28 are allowable, at least by virtue of their dependency.

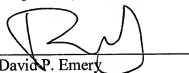
Additionally, with regard to claim 28, Appellant submits Dusterhoft fails to expressly disclose stopping the fluid injection after a predetermined time. Dusterhoft is silent with regard to any such feature. Rather, as set forth above, Dusterhoft focuses on the applied energy of the energy profile and the duration that this profile is applied. Nowhere does Dusterhoft disclose applying pressure for a predetermined time.

Thus, Appellant submits claim 28 is allowable for this additional reason.

CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David P. Emery', is written over a horizontal line.

David P. Emery
Registration No. 55,154

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: July 10, 2009